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Supreme Court of the United States

OCTOBER TERM 1941

No. 37

THE CUNO ENGINEERING CORPORATION,
Petitioner,
vs.

THE AUTOMATIC DEVICES CORPORATION,
Respondent.

REPLY BRIEF ON BEHALF OF DEFENDANT-PETITIONER ON WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SECOND CIRCUIT

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Plaintiff-respondent in its brief contradicts very few of our statements and arguments; but—

1. It now seems to rely upon a claim of broad novelty of concept instead of its former narrower interpretation.
2. It denies the necessity of any especial originality but implies that Mead's device was so to speak the detonator which started the Casco campaign.
3. It then disclaims any great success of the Mead device as such.
4. It insists upon misconstruing the functioning of the prior art devices.
5. It admits the need of extensive experiments to produce a commercial device.

6. It asserts that Mead's was a wireless lighter but fails to offer proof.

7. It makes little effort to clarify the claims of the patent.

8. It now proposes to reverse the opinions of the past ninety years and sustain claims upon novelty and utility alone.

We propose to comment on the brief generally in order of pages.

Exhibit 17 Not a Morris Lighter

Plaintiff-respondent on page 3 refers to the 1928 Casco lighter as the "Morris wireless lighter which car manufacturers soon began to adopt as standard equipment on their cars (R. 73, 74)."

The fact is that Exhibit 17 (offered R. 35) referred to on R. 73 and 74 was not a Morris lighter but a Casco lighter which used a wire resistor. So far as we know the Morris carbon heater device was never made by Casco.

No Signal in Mead's Patent

Plaintiff-respondent (pp. 4, 8) lays great stress upon the idea of a "click" or some other signal in the Mead device although there is not a word on the subject in the patent. Copeland 1,844,206 (R. 426) discloses a signal lamp 31, Figs. 1 and 2.

Hurxthal 1,540,628 (R. 398) refers to both an audible and visual signal for his toaster.

Cohen 2,117,703 (R. 465) claims quite broadly a lighter of the early Casco type with an audible signal. See claims 9 to 14.

Non-equivalents

On page 5 plaintiff-respondent refers to rotary and longitudinal motions as equivalent and notes *Bundy v. Detroit*, 94 Fed. R. 524. We might refer to *Weber v. Freeman*, 256 U. S. 668, 65 L. E. 1162, where this Court held to the contrary. Neither case, however, controls here. Actually it is the rotary socket, latch and spiral thermostatic spring return which are the distinguishing features of the Mead device. The plug was broadly old. Plaintiff's and defendant's lighters are not equivalents.

Development of Mead Required

It is most interesting to note that respondent's present brief (p. 5) admits that modern demands "required much development" of Mead and that (p. 11) "the case depends on what is disclosed and claimed in the Mead patent and not upon the little or great success of those early commercial embodiments". How much less can it depend upon the later successes of Caseo, Cuno and Sinko?

Cohen's development occurred before the purchase of Mead, not after, as implied on page 6.

Heat and Time

Respondent attempts to create the impression that a thermostat in Copeland's patent 1,844,206 (R. 425) acts after a predetermined time whereas Mead's device is responsive to heat. This is most misleading. In each case heat distorts the bimetal latch after a predetermined time. The parts are so designed that the release takes place when desired.

Respondent (p. 8) states as to Mead that the circuit is open "*As soon as* the igniter coil 83 is brought to the desired temperature". Claim 11 of Mead in fact says that the "heater member" is withdrawn "from the ON position

to the OFF position *upon* heating of said heater". This is definitely a time factor.

Mr. Johnson, plaintiff-respondent's president and expert, admitted that the temperature of the igniter or heater coil and the thermostatic device of Copeland 1,844,206 (R. 425) both rise at the same time (R. 224), of course at different rates as is the case in the Mead device.

There is no evidence that it takes any more or less time for an automatic lighter to get "ready" than for a non-automatic. Actually it is nearer 8 or 10 seconds than 15, as stated in respondent's brief on page 16. Mr. Cohen in the Sinko case (R. 83) testified to a time limit of 8 to 10 seconds.

Cohen Not Inspired by Mead

Respondent (pp. 11, 31) stresses Mr. Cohen's claim to having been inspired by Mead, but this is offset we submit by the portions of Mr. Cohen's testimony which we have quoted on pages 23 and 24 of our brief.

Furthermore, we call attention to a claim (R. 62) sworn to by Mr. Cohen in the application for his patent 2,117,703 (R. 459) filed July 23, 1932, reading as follows:

"In an Electric Cigar Lighter, the combination of a base member, a removable plug supported by said base member, an igniting element on said plug, and a thermostatic catch for locking the plug in the base member until the igniting element is heated a pre-determined extent."

Mr. Johnson had previously testified that he had seen a Mead device probably in 1929 and yet the above claim was later made by Mr. Cohen.

A stipulation appearing on R. 471-473 includes a quotation from the original application for Mr. Cohen's patent 2,140,311 which we submit conclusively proves that he did not know of the Mead device when that application was filed.

Substantially identical language is found in Mr. Cohen's patent 2,117,703 (R. 461) beginning on page 1 of that patent, line 4, and extending to line 19 in the second column. This was filed July 23, 1932. It does not seem possible that Mr. Cohen could have made any such contention as to his invention in 1932 if prior thereto he had been inspired by the Mead device or by the Mead patent.

Mead's patent was bought by Caseo Products Corp. May 3, 1934 (R. 18).

Mead's Claims Recast

On page 13 respondent attempts to recast Mead's claims of novelty, "i. e., the combination of the plug, resistance coil and socket elements with a thermostat responsive to the temperature of the heating element or glow member." Unfortunately this would not constitute a useful lighter—nor is it what Mead claimed.

Plaintiff-respondent disclaims any intention to interpret Mead's claims broadly and states that they left open to the public all other ways of opening the circuit to the igniter. In view of respondent's contention that the claims cover structures so radically different from that disclosed by Mead such as the Cuno, Sinko and Caseo lighters, it is difficult to see how one could make a simple and satisfactory automatic lighter of a type suitable for insertion into a socket in a dash which would not come within the broad scope claimed by the respondent. Sinko has simply modified the prior Zeechini patent 1,437,701 (R. 390) structure. Caseo has modified the Wolfson lighter 1,980,157 (R. 433) which was certainly developed in 1931 without the aid of Mead. And Cuno has developed the Ashton Ford type lighter 2,060,783 (R. 440). As respondent construes them, the claims would cover the mere addition of a thermostatic latch to the Morris device 1,376,154 (R. 386).

Prior Art Misconstrued

Respondent on page 20 incorrectly states that "In every prior device having a thermostatic control, either the operation of the thermostat was placed under the control of some other thing, such as the sole plate of an electric iron, or of an auxiliary resistance whose only function was to operate the thermostat after the lapse of a predetermined time, or upon abnormally heavy surges of current".

In Harley 852,326 (R. 355) the thermostatic cutout 8 is actuated by the heat from the resistance coil 7.

In Andrews 1,025,852 (R. 358) the thermostatic device 15 is actuated by the heat from the coil (Fig. 4).

The same action occurs in Denhard 1,143,572 (R. 363), see claim 8, R. 367. Obviously it is the heat from the coil that actuates the thermostatic release of the switch. Of course it isn't the temperature of the coil that actuates any of these devices, but the heat given off. In no case does the thermostatic device reach a temperature anywhere near that of the active heating coil. Mead proposed a spiral bimetal spring so close to the heater coil as to make it impracticable.

Thermostatic Control an Old Tool

Plaintiff-respondent on page 20 of its brief admits that "thermostatic controls * * * were known 'tools' in the electrical and other arts * * * and no one may rightfully patent their use for any particular purpose". It contends, however, that Mead has utilized this tool in a new combination.

Mead did not introduce a "new mode of operation" as claimed by respondent except to insert a plug into a rotatable socket and rotate it by turning the plug. The entire plug has two positions in the socket. All that Cuno and Sinko do is to push a switch contact into closed circuit position like in any push button switch. There it is

held by a thermostatic latch similar to the latch 13 in Stahl 1,372,207 (R. 379). This does not constitute a new mode of operation or produce a new result.

A Serious Mead Defect

In the Mead lighter, the plug can be held by hand in the closed circuit position and burned out, but this is not possible with the Cuno lighter where if the knob and sliding contact are held *in* the bimetal fingers will open and close as in the Harley hunting thermostatic device of patent 852,326 (R. 355) without doing any harm.

Mead's Failure

On page 24 of its brief respondent contends that it did not occur to others that by "picking out a suitable thermostat and then making certain modifications and changing the principle of operation, the wireless cigar lighter could be so altered that the improved lighter when offered to the public would make practically obsolete all other lighters".

We submit that Mead did not pick out "a suitable thermotstat" nor did he make such changes or change the principle of operation so as to supplant other lighters. Mead's lighter was never a success. He made no progress.

Best Art Not Cited by Patent Office

On pages 23 and 24 respondent refers to certain prior art.

The only references cited by the Patent Office against the Mead application (R. 472) were Metzger 1,622,334 (R. 401) and Harley 852,326 (R. 355). Had the Mead patent received the careful attention it should have had in the Patent Office and had the facts here presented been known to the Patent Office Examiner, we submit that the claims

in suit would never have been granted under Section 4893 of the Revised Statutes or Section 4886 of the Revised Statutes.

Mead's Thermostatic Device

Respondent on pages 29 and 30 has misconstrued our criticism of the Mead device on page 18 of our brief. In Mead it takes time for the igniter coil to get hot and the thermostatic device gets to its lower actuating temperature by reason of the heat transferred to it from the igniter coil and the heat produced by the passage of current through the bimetal (if it is in circuit). In Copeland 1,844,206 (R. 425) and in Mead it is the energy of the electric current passing through the device which actuates the thermostatic device to open the circuit at the pre-designed time. In both cases it takes time and that time will vary with the characteristics of the device and the ambient atmospheric conditions.

Respondent questions our contention that Mead discloses the idea that the latch might be entirely heated by the current flowing through it and yet Mr. Johnson in the Sinko case (R. 51) admits just that. In other words, Mead contends that he does not need to use the igniter as the heating means. And Johnson admits (Sinko R. 52) that with such a structure the "break" would not depend directly upon the temperature of the heating coil. If this is so then Mead must have regarded heat from the igniter coil and heat created by the resistance to current passing through the latch as equivalents. As respondent now contends to the contrary, the public cannot be blamed for being misled as to the possible scope of the claims in issue.

Cuno's Lighter Similar to Sinko's

Respondent contends that the Sinko and Cuno lighters are substantially the same (p. 33 of its Brief). So far as the claims in suit are concerned this is probably true, although we understand that in the Sinko case the defendant contends that its device which was found not to infringe the Mead claims is structurally different from the Cuno lighter. However, as the Sinko device is free the Cuno lighter should also be free.

The Sinko Lighter and the Prior Art

In the Sinko lighter referred to by respondent on page 3 of its brief, the thermostatic latch member is located within the plug (not in the socket) so that the release is effected by heat produced by the current which passes through the latch and through the heater coil. Heat from the heater coil is transmitted by conduction through the adjacent parts of the plug. This is precisely the way heat is transmitted to actuate the release of the latch in the Andrews Automatic Cut-out for Electric Heater in patent 2,025,852 (R. 359) and in Denhard's Electric Heater 1,143,572 (R. 363) and Newsom's Coffee Cooker 1,318,168 (R. 52) to open the circuit when the parts have reached a predetermined temperature.

As we read the decision of the Circuit Court of Appeals for the Second Circuit, it found that broad patentable invention was involved in merely applying such an arrangement to a cigar lighter even though it was done in an impracticable manner.

Mead's Combination Neither Useful Nor Properly Claimed

On pages 34 et seq. respondent urges validity and infringement of claims 2, 3 and 11, and in seeking a broad construction is obliged to overlook the requirement of the claims that the heating member is moved when closing the circuit. While this is true in the Mead device since the entire plug with the igniter unit is rotated to close the circuit, no such construction or operation can be found in the Cuno or Sinko devices. In both of these devices the igniter or heating unit stands still all the time while the plug is in the socket.

This shows to what extremes the respondent is forced to sustain the validity of the claims and at the same time urge infringement.

We submit that the movement of a switching member as in the Cuno and Sinko lighters while the heater element is stationary is not the equivalent of the moving of the entire plug and heater as in the Mead patent. The attempt by the respondent to so twist the language of the claims as to cover the defendant's lighters, we submit, demonstrates that the claims are not so clear and distinct as to comply with the requirement of Section 4888 of the Revised Statutes.

The Court of Appeals held "it is the conception that counts, the act of imagination which assembles the elements into the new and fruitful combination" (R. 509).

With this conclusion we might agree if the combination were new and fruitful and disclosed and claimed as required by law. However, as stated recently by this Court in *Altoona Publix Theatres, Inc. v. American Tri-Ergon Corp.*, 294 U. S. 477, the combination "is one which was neither claimed nor granted" in the Mead patent and cannot properly be called "fruitful".

Morris Patent Not Before the Court in the Sinko Case

The Circuit Court of Appeals (R. 509) referred to the Seventh Circuit case and to the Morris patent 1,376,154 (offered R. 98, printed R. 386) as if the Court in Chicago had found that Mead had made only a minor improvement over Morris. The fact is that the Morris patent to which we have been referring was not in evidence in the Sinko case. How the Court could have been so misled we do not know.

Mead Not Responsible for Improving Cigar Lighters

On pages 38 and 39, respondent seems to claim credit is due Mead for improving wireless lighters in 1927 or 1928. The fact is that wireless lighters appear to have first come into general use about 1927 or 1928 about the same time that Copeland and Mead were working on the subject. We have no figures as to sales, however, in the record until 1931 when the Wolfson lighter 1,980,157 known as the Cuno model 2600 came on the market (R. 315). This was improved and became popular in 1934 as the Ford type lighter (Cuno model 1700). Plaintiff's Exhibit 26 (offered R. 81) tabulates the Cuno and Casco sales from 1934 to 1938.

We submit that Casco's commercial automatic lighter was a simple development of the Cuno device of this Wolfson patent 1,980,157 (R. 433) under which Casco was licensed by Cuno (R. 116).

Requirements of a Successful Cigar Lighter

To be successful, as shown in the Cuno, Sinko and Casco lighters:

- 1) The socket must be stationary.
- 2) There must be one or more abutment contacts in the bottom of the socket to take up the thrust of the plug when inserted.

- (3) The plug must be cylindrical and without lateral projections so that it can be inserted into the socket in any rotated position (no keyhole "fishing").
- (4) The plug must have an end contact around the igniter coil at its inner end to engage the abutment contact in the socket.
- (5) There must be another contact within the socket to be engaged by a part of the plug.
- (6) The retracting spring must be in the plug as far from the hot igniter coil as possible so that it will not be annealed.

Every one of these features is present in the Cuno, Sinko and Casco lighters. Not a single one of them is found in the Mead patent.

For an automatic lighter there should be added a bimetal latch separate and distinct from the retracting spring to engage and hold a relatively movable part of the plug when it is thrust straight into the socket.

This element is present in all the successful automatic lighters but will not be found in Mead's device which uses the spiral bimetal return spring.

Evidence of Alleged Invention

Respondent on page 38 refers to seven years between Morris and Mead. This does not indicate invention by Mead because Mead was not appreciated or adopted. The fact is that when the industry wanted improved lighters it devised suitable adaptations of the non-automatic lighters available and in doing so disregarded the impracticable teachings of Mead.

Respondent overestimates the importance of thermostatic control. It is a convenience but has not supplanted non-automatic devices. When the non-automatic had been perfected, it was a simple matter to add a thermostatic latch but not in the manner proposed by Mead.

Efforts by others to improve features of cigar lighters cannot be regarded as evidence to sustain the validity of the Mead claims.

Respondent on page 41 refers to the changes required to make Mead's combination. This might be true as it did require material changes to make the useless Mead device but it required extremely simple changes in the current lighters to make the Wolfson, Zeechini and Ashton lighters automatic.

On page 42, respondent states that a return to the non-automatic would be a retrogression. It is submitted, however, that a return to anything like the Mead structure is impossible to conceive. In the Mead device, we submit that the keyhole "fishing" action required to replace the plug would more than offset any saving in time required to hold a plug in the closed circuit position. At any rate, Mead did not claim or mention any safe driving feature.

Casco's Advertising

On page 42, plaintiff-respondent implies that commercial success of Casco was not due to advertising, "Hence there is no such showing of such 'prodding'." This overlooks Mr. Cohen's testimony as to a national advertising campaign (R. 81). Mr. Cohen tried to create the impression that the advertising did not "draw" but the answer was they sold the Casco lighter.

We call the Court's attention to the samples of advertising, Defendant's Exhibit E (offered R. 89, printed R. 342) and Defendant's Exhibit F (R. 343). Exhibit E (R. 342) shows the advertisement in the Saturday Evening Post of April 10, 1937, Casco lighter. Exhibit F (R. 343) refers to Casco National Advertising—"Over 83 million advertisements . . . full pages in color and dominant copy . . . will be carried by the leading National magazines shown in this ad." On this page is shown the title headings of The American Weekly, Collier's, Life and The Saturday Evening Post—all of which have extremely wide circulation.

A New Test of Patentability!

Plaintiff-respondent on pages 43-45 makes a most astonishing contention as to the proper basis of a patent, i.e., "The degree of ingenuity, we submit, is not the test. Rather, the test is—is the invention new?"

We know of no recognized American case which supports this theory. If respondent is correct, any novelty however slight is sufficient to support a patent. Even if this were the statute law, there is still the requirement of a valid claim directed to the novelty and utility. Under the law the invention must also be useful and we have conclusively shown, we submit, that Mead's device as claimed was not useful. Furthermore, Congress has no power to grant monopolies except under Article 1, Section 8, to promote the progress of science and the useful arts, and no patent can be valid under the Constitution unless it fulfills this requirement.

Respondent also overlooked Section 4893* of the Revised Statutes which limits the grant of patents to inventions which are "sufficiently useful and important". We submit that the Commissioner of Patents overstepped his authority in granting the claims in suit.

Plaintiff-respondent makes no attempt to prove that the Mead patent is valuable. That it has been damaged is scarcely sustained by the record which shows that the Casco Products Corporation pays no royalty or consideration for its use other than an agreement to pay for development and litigation. It would appear to be trying to build up a patent monopoly.

There are therefore in this case none of the factors which sometimes tend to turn the scales of doubt toward the plaintiff's case.

* Sec. 4893 R. S. On the filing of any such application and the payment of the fees required by law the Commissioner of Patents shall cause an examination to be made of the alleged new invention or discovery; and if on such examination it shall appear that the claimant is justly entitled to a patent under the law, and that the same is sufficiently useful and important, the commissioner shall issue a patent therefor.

Conclusion

We submit that to grant a monopoly for the manufacture, use and sale of automatic cigar lighters based on the Mead disclosure would be contrary to the law and the intent of the Constitution.

An enormous amount if not most of the litigation on patent rights is due to inadequate disclosure and the issue of vague and indefinite claims—the scope of which is not clear.

Under the American patent system, the inventor must describe his invention

"in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound, and use the same; and in case of a machine, he shall explain the principle thereof, and the best mode in which he has contemplated applying that principle, so as to distinguish it from other inventions" (R. S. 4888).

Not only must he thus describe his invention so that the public can produce it without experimentation (*Incandescent Lamp Patent Case*, 159 U. S. 465), but

"he shall particularly point out and distinctly claim the part, improvement or combination which he claims as his invention or discovery" (R. S. 4888).

Respondent's brief treats the Mead patent as if it were for an automatic wireless lighter although nowhere does the patent speak of the alleged safety feature of a wireless lighter nor are the claims in issue restricted to a wireless lighter.

The public is entitled to know without any doubt not only what the real invention is—but what the inventor claimed and what the Government granted, not what he could or should have claimed. Not what he was entitled

to but what he claimed and was granted. The law provides a specific remedy when an inventor fails to properly claim his invention. Our laws do not provide for judicial reconstruction of faulty claims. Those who are too lazy or too ignorant to draw proper claims would like to be able as they are in Great Britain to claim "what I have shown and described"—and then let the poor public make its own search of the art and guess what some Court may be persuaded by clever counsel to believe it to be.

We submit that the claims in suit are invalid and that this suit should be dismissed.

Respectfully submitted,

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